

A marked-up version of claim 2 is as follows:

2. (Amended). The formulation of claim 1, wherein said antibiotic is selected from the group consisting of florfenicol, [any] a salt of oxytetracycline, chlortetracycline, tetracycline, gentamicin, chloramphenicol, tylosins, cephalosporins, and combinations thereof.

### **Remarks**

Reconsideration of the subject application is requested. Claims 1-3, 6-7, and 16-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,151,270 to Grimberg ("Grimberg"). Still further, claims 1-21 were rejected under 35 U.S.C. § 103(a) as being obvious and thus unpatentable over Grimberg in combination with the Veterinary Drug Handbook by Donald C. Plumb ("Plumb"). Claims 18-21 were rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable a person skilled in the art to use the invention commensurate in scope with these claims. In addition, claim 2 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

#### **I. § 112 Rejections**

The specification provides enablement for claims 18-21. Specifically, the specification provides enablement for the treatment of an animal having pain, inflammation, fever and/or infection at page 5, lines 18-22. Therefore, the rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn. Applicant has amended claim 2 as recommended in the Office Action to overcome the § 112, second paragraph, rejection.

#### **II. §§ 102 and 103 Rejections**

Applicant respectfully submits that claims 1-3, 6-7, and 16-18 are not disclosed or suggested by Grimberg. Grimberg does not disclose or suggest an antibiotic and an analgesic dissolved in a solvent, which forms a veterinary formulation, as claimed in 1. Grimberg also does not disclose or suggest a solution

comprising an antibiotic and an analgesic, as claimed in claim 16. Still further, Grimberg does not disclose or suggest administering to an animal a formulation comprising a mixture of an antibiotic, an analgesic, and a solvent, as claimed in claim 18. Grimberg discloses a cream that is not absorbed externally but instead solidifies after application. In contrast, Applicant's claimed formulation is absorbed internally making it a systemic formulation whether it is applied as a pour-on liquid or as an injectable. Claims 2-3, 6-7, and 17 depend from either claim 1 or claim 16 and are not disclosed or suggested by Grimberg for the same reasons claims 1 and 16 are not disclosed or suggested.

Applicant respectfully submits that a prima facie case of obviousness for rejecting pending claims 1-21 under § 103 has not been established. Neither of the cited references discloses Applicant's claimed invention. Furthermore, the cited references are not properly combinable. Still further, even if the cited references are combined, they do not disclose Applicant's claimed invention. The Patent and Trademark Office's burden of establishing a prima facie case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 26 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1993)(quoting In re Rinehart, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976)). Pending claims 1-21 have been rejected based on an improper combination of references which fail to suggest the claimed invention. The Patent and Trademark Office's burden of establishing a prima facie case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 26 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1993)(quoting In re Rinehart, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976)). Pending claims 1-21 have been rejected based on an improper combination of references which fail to suggest the claimed invention.

As discussed above, Grimberg does not disclose or suggest a formulation comprising a mixture of at least one antibiotic, at least one analgesic, and at least one solvent, wherein the antibiotic and the analgesic

are dissolved in the solvent to form a mixture, as claimed in claims 1-15. Still further, Grimberg does not disclose or suggest a method of making an antibiotic/analgesic formulation that includes mixing an antibiotic with a solvent to form a solution, adding an analgesic to the solution, and mixing the solution to form an antibiotic/analgesic formulation, as claimed in claims 16-17. Further, Grimberg does not disclose or suggest administering this formulation to an animal in need thereof, as claimed in claims 18-21.

Grimberg discloses a dermatologic cream for humans used to soften the skin and reduce wrinkles. Grimberg does not disclose or suggest an antibiotic and an analgesic being dissolved in a solvent, but rather these components merely are suspended in the cream. Plumb merely discloses a list of various chemicals, but does not disclose a solution comprised of both an antibiotic and an analgesic.

Applicant's claimed formulation is clearly distinguishable from that disclosed by Grimberg or Plumb. Furthermore, "[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." In re Jones, 21 U.S.P.Q. 2d 1941, 1943-44 (Fed. Cir. 1992). If there is no technological motivation for modifying a reference and/or if there is a disincentive for doing so, then the reference should not be part of a § 103 rejection. Still further, if the invention is disclosed by any reference modified so as to destroy its intended purpose, then a prima facie case of obviousness has not been made. In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

There is no suggestion by the cited references that the cream of Grimberg with active components suspended therein should be made into a solution and used for veterinary use. Still further, there is no suggestion by the cited references that various components listed in Plumb should be combined into a solution. The Federal Circuit has held that:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification . . . it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992). Pending claims 1-21 should not be rejected based on 35 U.S.C. §§ 102 and 103.

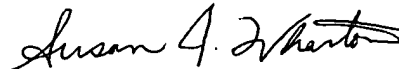
Still further, even if combined, the combination of Grimberg and Plumb does not disclose or suggest Applicant's claimed invention. This combination does not suggest putting an antibiotic and an analgesic in solution to create a formulation to be administered to animals, as claimed by Applicant. For the foregoing reasons, claims 1-21 are not obvious over Grimberg in view of Plumb.

### III. Conclusion

In view of the foregoing amendments and remarks, it is believed that this application is in condition for allowance. Accordingly, Applicant requests that the rejections under §§ 102, 103 and 112 be withdrawn. Reconsideration and allowance of pending claims 1-21 are respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that are required to Deposit Account No. 19-2112.

Respectfully submitted,



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